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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/107,237	06/30/1998	ALAN HERROD	SYM-0625	7741

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EXAMINER

FOURSON, GARY SCOTT

ART UNIT

PAPER NUMBER

2151

DATE MAILED: 12/28/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/107,237

Applicant(s)

HERROD ET AL.

Examiner

Gary S. Fourson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 1998.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-16 and 33-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims 17-32 and 49-64 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5, 6.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16 and 33-48, drawn to associating a data entity to a data field of a software application based on identification information regarding the input source of the data, classified in class 709, subclass 329.
- II. Claims 17-32 and 49-64, drawn to transferring an application's output data to one or more output destinations based upon identification information regarding the destination of the data, classified in class 709, subclass 313.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as utilizing input source identification information stored within a data entity to transfer the data entity to a software application as well as associate the data entity with a data field in the software application without any need to consult destination information stored in the data entity. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Kenneth D'Alessandro (Reg. No. 29,144) on November 8, 2001 a provisional election was made without traverse to prosecute the invention of group I, claims 1-16 and 33-48. Affirmation of this election must be made by applicant in replying to this Office action. Claims 17-32 and 49-64 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

1. This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed. A three-month requirement exists for filing the formal drawings in the event of an allowance, and extensions of time are not permitted. This three-month period also includes any resubmission of formal drawings required in the event that the first formal drawing submission is objected to by the draftsman.

Specification

2. The disclosure is objected to because of the following informalities:

In the PRELIMINARY AMENDMENT (paper no. 4) dated July 2, 1998, Applicant intended entry of two corrections to the specification. However, the occurrences of the two amendments do not coincide with the line numbers specified in paper no. 4. The occurrence of "date" is on line 15 of page 6 (not line 9), and the occurrence of "rather" is on line 13 (not line 12) of page 12. Examiner requests formal corrections of the proposed preliminary amendments, which have not been entered.

Page 1: The related patent number (US 6,237,053 B1) is missing from the specification. The Examiner requests that Applicant provide the missing number in a formal amendment to the specification.

Appropriate corrections are required.

Claim Rejections - 35 U.S.C. § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. **Claims are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

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Claims 1 and 33 recite the limitation "said data fields" in lines 7 and 6, respectively. There is insufficient antecedent basis for this limitation in the claim. Applicant appears to be referring back to said *one or more* data fields as recited in the preamble, and the Office will interpret the limitation as such for initial examination purposes only. Appropriate correction is required.

Claim Rejections - 35 U.S.C. § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims rejected under 35 U.S.C. 103(a) as being unpatentable over Arai et al. (US 5,119,479).**

With respect to claims 1, 2, 6, 12-16 and 33, 34, 44-48, Arai et al. teaches a data entity [col. 6 lines 18-29; input data from mouse] including identification information [input device name] regarding the input source [mouse or other logical input device means] of the data stored therein, transferring ["transmits the input data from the mouse 103 (input device) for logical input device execution to the UI execution function."] the entity to an application, and associating the entity with an application [col. 7 lines 15-16] based upon the identification information [cols. 5-6]. It would have been obvious to one of ordinary skill in the art that the data is associated with a data field of an application as claimed, because the programs must declare variables or data fields for program data in order to allocate memory.

As to **claims 6 and 38**, Arai teaches identification information including time and position [cursor coordinates]. It would have been obvious to include other uniquely identifying information in the data objects transmitted from an input source to an application in order to assure delivery.

As to **claims 3-5, 7-11, 35-37, and 39-43**, Arai et al. teaches logical device input rules [form objects] in col. 5-6.

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Pertinent Prior Art

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Rickenbach et al. (US 5,233,686) teaches backplane architecture for associating input from multiple sources to a plurality of independent application programs and associated display generation routines. [col. 6 lines 47 et seq.; col. 9 lines 40-57; Fig. 6]

Lo et al. (US 5,911,044) teaches TWAIN input device interfacing and a scan to application process to allow control of a scanner or other image-acquiring device.

Conclusion

Any inquiry concerning this communication should be directed to Gary Fourson at telephone number (703) 305-4392 or E-mail at the address gary.fourson@uspto.gov.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

The fax numbers for Official (703-746-7239), to be intended for entry into the application, Non-Official/Draft (703-746-7240), or After-final (703-746-7238) communications may be utilized for expedited transactions.

gsf

December 17, 2001



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